UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,815	10/20/2003	Taro Ikeda	03500.017675	2611

5514 7590 04/05/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
LEE, PETER	

ART UNIT	PAPER NUMBER
2852	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/687,815	IKEDA ET AL.J	
	Examiner	Art Unit	
	Peter Lee	2852	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *7 and 8* is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☒ Claim(s) *5 and 6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 1 of the current application is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 10/687813. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim one in the current application is seen to be broader and encompasses the limitations taught in claim one of application No. 10/687813. It is obvious to see that the "plurality of developing devices" taught in claim 1 of the application is satisfied by the first and second developer carrying members in the earlier application No. 10/687813.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuma et al. (US pn 5160969) in view of Kashiwabara (Japanese patent 11-2961).

Mizuma teaches an image forming apparatus (Fig. 6) comprising: Four separate developing containers (Fig. 6 parts 107, 109, 111, 113; note col. 14 lines 35-41) (ie. plurality of developing devices) corresponding to four separate colors to perform a color developing process with respect to the electrostatic latent image formed on the photosensitive body belt (Fig. 6 part 101) (ie. image bearing member); a rotating developing device (fig. 6 part 137) (ie. rotary member holding plurality of developing devices) for holding the four developing containers and bringing them to the proper first developing position (Fig. 6 reference P1; note col. 14 lines 35-41) (ie. selevtively moving any one of said developing devices to a developing position).

Mizuma does not teach the four developing containers having the claimed first and second developer carrying members.

Kashiwabara teaches a first developer application means (fig. 1 part 30) and second developer application means (fig. 1 part 40) (ie. developer carrying members) for carrying developer to a photosensitive drum (fig. 1 part 2) (ie. image bearing member); the developer application means are taught to have a spring member used to bias them towards the photosensitive drum either as a single unit (fig. 1 part 20) or individually (fig. 2 part 46 shows the spring biasing the first developer application means; fig. 6 part 46 shows the spring biasing

the second developer application means) (ie. relatively rockable). Kashiwabara also teaches a development gap adjustment means (fig. 3 part 50) for ensuring a set clearance between the developer application means and the photosensitive drum (paragraph [0018] – [0019]) (ie. predetermined positions with respect to the image bearing member).

Kashiwabara also teaches an abutting member (ie. abutting/hitting member) to be attached to one of the said developer application means to abut against the said photosensitive drum. When the abutting member (Fig. 6 part 47; paragraph [0025]) is attached around the second developer application means, the first developer application means is seen to have its non-contact distance to the photosensitive drum ensured (fig. 6 note space DG1) (first developer carrying member is opposed to the image bearing member with a predetermined distance), and the abutting means ensures the second developer application means a physical contact distance of DG2 from the photosensitive drum.

Kashiwabara also teaches a supporter material (fig. 7 part 63) for attaching to the first developer application means (part 30) and its support shaft (part 33) for pivoting the first and second developer application means towards and away from the photosensitive drum (part 2) (paragraph [0026]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the single position developing device seen in Kashiwabara and put it into a multiple unit rotary apparatus as found in Mizuma. Combining a single toner device into a color image forming device is further supported in the fact that the reference invention taught by Mizuma that includes the multiple developing device rotary member also includes a second and separate developing device (fig. 6 part 151; Mizuma) specifically set aside for black

developer (col. 14 lines 52-60). One of ordinary skill in the art would have been motivated to bring the dual developer application means setup as seen in Kashiwabara into the rotary device seen in Mizuma because the dual developer application means has the ability to develop more of the latent image on the image bearing member, thus increasing the image formation rate of the overall image forming apparatus (Kashiwabara [0002]).

By combining the two references, Kashiwabara into Mizuma, the limitation of the second developer carring member being disposed upstream of the first developer carrying member in a rotation direction is taught.

Response to Amendment

Amendments to the claims and specification have been entered.

Allowable Subject Matter

2. Claims 5-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3. Claims 7-8 are allowed.

The primary reason for allowance of claims 7-8 is the inclusion of a first operation mode in which a first developer carrying member is used alone, and a second operation mode where both

a first and second developer carrying member are used which is found in all of claims 7-8, but not disclosed nor suggested by the prior art of record.

Response to Arguments

4. Applicant's arguments, see p. 12, filed 31 January 2005, with respect to claim 1 have been fully considered and are persuasive. The rejection of claim 1 based on Kimura et al. has been withdrawn.

5. Applicant's arguments filed 31 January 2005 have been fully considered but they are not persuasive.

Claims 1-4 are still rejected under the teachings of Mizuma et al. in view of Kashiwabara. On p. 13 first paragraph of the applicant's response, it is argued that Kashiwabara does not disclose a member capable of rocking the developing devices relative to a rotary member. However it is taught by Kashiwabara to have a supporter material (fig. 7 part 63) for attaching to the first developer application means (part 30) and its support shaft (part 33) for pivoting the first and second developer application means towards and away from the photosensitive drum (part 2) (paragraph [0026]).

In response to applicant's argument that there is no suggestion to combine the references of Mizuma in view of Kashiwabara, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it has been noted in the first office action that the motivation for combining the teachings of plural developer application means taught by Kashiwabara is for the improvement in an image formation rate (paragraph [0002]). Therefore, one of ordinary skill in the art would have been motivated to modify the rotary developing apparatus as taught in Mizuma to have the plural developer application means as taught in Kashiwabara in order to improve an image formation rate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Lee whose telephone number is 571-272-2846. The examiner can normally be reached on mon-fri 9:00 am-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on 571-272-2136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PL 4/4/2005

Arthur T. Grimley
Supervisory Patent Examiner
Technology Center 2800